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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,926	08/26/1999	FRANK D. D'AMELIO	CIR-990826	8498

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EXAMINER	
LEE, Y YOUNG	

ART UNIT	PAPER NUMBER
2613	10

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/384,926	Frank D. D'Amelio et al
Examiner	**Art Unit**
Y. Lee	2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 9, 2003*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-3, 16-18, 20-22, 24-26, and 35-102* is/are pending in the application.

4a) Of the above, claim(s) *24-26 and 35-102* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-3, 16-18, and 20-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of claims 1-3, 16-18, and 20-22 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there is no serious burden. This is not found persuasive because according to MPEP section 803, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. It is noted, for example, that the search for group I (claims 1-3, 16-18, and 20-22) does not require a search for the capability of a medical instrument for use in imaging a target site in a medical procedure, as claimed in Group VI (claims 48-96), since an endoscope has many utilities other than a medical procedure. Therefore, Examiner would not have to search all of the subclasses of class 600 in order to conduct an accurate and thorough search.

It is further noted that the number of subclasses or class to be searched is irrelevant to the restriction requirement. A greater number of subclasses directed to each of the Groups does not necessarily cause "serious burden" in examination. The serious burden is solely caused by the fact that the claimed subject matter in Group I (claims 1-3, 16-18, and 20-22) and the rest of the Groups are separately classified and require different fields of search.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 24-26 and 35-102 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5. Claim 20 is objected to because of the following informalities: line 19, before "compensating", --and-- should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 16, 17, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Flagle (3,654,385).

Flagle, in Figure 2, discloses a color television system with the same apparatus for compensating differential picture brightness of an optical image due to uneven illumination as specified in claims 1-3, 16, 17, and 20-22 of the present invention, comprising a device 83 for generating a compensating signal substantially representing at least one parameter of a compensating waveform required for the differential picture brightness of an optical image to produce a video signal 84 representing an optical image having a substantially uniform brightness; an adder 40 operatively coupled to the compensating signal generating device and a video signal for adding the sawtooth waveform, the parabolic waveform and the video signal to produce an output video signal to a video signal processor to adjust its gain both vertically and horizontally compensated by increasing the gain of the video signal representing that part of the optical image which is less bright than a reference and reducing the gain of the video signal representing that part of the optical image which is brighter than a reference compensating the video signal to represent an optical image having a substantially uniform brightness; a control device operatively coupled to the adder to increase the brightness of the compensating signal to a

level which is greater than the average of the differential brightness of the optical image due to the uneven illumination (Fig. 2).

8. Claims 1-3, 16, 17, and 20-22 are also rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's admitted prior art.

Applicant's admitted prior art, on pages 2-7, discloses the same apparatus for compensating differential picture brightness of an optical image due to uneven illumination from an endoscope imaged onto a video camera as specified in claims 1-3, 16, 17, and 20-22 of the present invention, comprising a device for generating a compensating signal substantially representing at least one parameter of a compensating waveform required for the differential picture brightness of an optical image to produce a video signal representing an optical image having a substantially uniform brightness (p. 2-5); an adder operatively coupled to the compensating signal generating device and a video signal for adding the sawtooth waveform, the parabolic waveform and the video signal to produce an output video signal to a video signal processor to adjust its gain both vertically and horizontally compensated by increasing the gain of the video signal representing that part of the optical image which is less bright than a reference and reducing the gain of the video signal representing that part of the optical image which is brighter than a reference compensating the video signal to represent an optical image having a substantially uniform brightness (p. 5); a control device operatively coupled to the adder to increase the brightness of the compensating signal to a level which is greater than the average of the differential brightness of the optical image due to the uneven illumination (p. 5-7).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flagle in view of Topper et al (5,157,497).

It is noted Flagle differs from the present invention in that it fails to particularly disclose an amplifier as specified in claim 18. Topper et al however, in Figures 1 and 2, teaches the concept of such well known video driver amplifier 200 operatively coupled to the adder 50 the output video signal to a video camera 500 through a low impedance.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both the references of Flagle and Topper et al before him/her, to modify the analog system of Flagle to be upgraded as a digital apparatus by simply utilizing an A/D converter to convert the camera output to include the same digital camera means and competitive processing equipment as specified in claims 8, 11-15, 31, and 33. With an upgraded digital system, one of ordinary skill in the art would have had no difficulty in applying subsequent digital processing such as storing and retrieving the digitized images from the storage device 14 by the controller, as illustrated in Figure 1 of Flagle, since digital processing are necessary and well known techniques for any digital system.

11. Claim 18 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Topper et al (5,157,497).

It is noted Applicant's admitted prior art differs from the present invention in that it fails to particularly disclose an amplifier as specified in claim 18. Topper et al however, in Figures 1 and 2, teaches the concept of such well known video driver amplifier 200 operatively coupled to the adder 50 the output video signal to a video camera 500 through a low impedance.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both the references of Applicant's admitted prior art and Topper et al before him/her, to modify the differential picture brightness compensating system of Applicant's admitted prior art to include the well known video driver amplifier of Topper et al in

order to apply subsequent compensation to the video signal processor, since video compensation at a low impedance is a necessary and well known technique for many video systems.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-3, 16-18, and 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent

No. 6,100,920. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are broader than the ones in the patent. 214 U.S.P.Q. 761 In re Van Ornum and Stanz.

Conclusion

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Or:

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

Y. LEE
PRIMARY EXAMINER

Y. Lee/yl
January 15, 2004